

ESTTA Tracking number: **ESTTA651879**

Filing date: **01/23/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91215512
Party	Plaintiff BODY VIBE INTERNATIONAL, LLC
Correspondence Address	THOMAS P PHILBRICK ALLMARK TRADEMARK 2089 AVY AVE MENLO PARK, CA 94025 UNITED STATES tom@allmarktrademark.com, allmarktrademark@gmail.com
Submission	Motion for Sanctions
Filer's Name	Thomas P. Philbrick
Filer's e-mail	tom@allmarktrademark.com, allmarktrademark@gmail.com
Signature	/Thomas P. Philbrick/
Date	01/23/2015
Attachments	Cover pages for Rule 11 motion filed with Board 01232015.pdf(394622 bytes ) EXHIBIT A LABEL.pdf(50786 bytes ) Scan of Dr. Vape RULE 11 motion served 12192014.pdf(1095183 bytes ) Exhibit A cover sheet to Dec 19 rule 11 motion.pdf(150484 bytes ) exhibit A to Dec 19 rule 11 motion.pdf(1535536 bytes ) Exhibit B cover sheet to Dec 19 rule 11 motion.pdf(140431 bytes ) exhibit B to Dec 19 rule 11 motion.pdf(1149690 bytes ) EXHIBIT B LABEL.pdf(50319 bytes ) Huber letter of Dec 30th.pdf(321618 bytes ) EXHIBIT C LABEL.pdf(50575 bytes ) Reply to Mark Hubert letter dated Dec 30th re amended pleading and Rule 11 01092015.pdf(420447 bytes ) certificate of service for Rule 11 motion filed with Board on 01232015.pdf(107344 bytes )

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re application serial no. 85966358 (DR. VAPE)

Filed on June 21, 2013

BODY VIBE INTERNATIONAL, LLC	)	
	)	
Opposer,	)	
	)	Opposition No. 91215512
v.	)	
	)	
Cox, David	)	
	)	
	)	
Applicant.	)	
<hr/>		

Trademark Trial and Appeal Board  
United States Patent and Trademark Office  
P.O. Box 1451  
Alexandria, VA 22313-1451

**OPPOSER'S MOTION FOR RULE 11 SANCTIONS AGAINST APPLICANT WITH  
RESPECT TO ANSWER FILED OCTOBER 17, 2014**

BODY VIBE INTERNATIONAL, LLC, a limited liability company legally organized under the laws of New Mexico, with a principal place of business of 11445 E. Via Linda, Suite 2626, Scottsdale, AZ 85259, (hereinafter "Opposer"), hereby submits the following Motion for Rule 11 Sanctions against Applicant and his attorney.

**A. Background**

Opposer served on Applicant the attached Rule 11 Motion (**Exhibit A**) by 1<sup>st</sup> class mail on December 19, 2014. Applicant's only correspondence during the 21 day "safe harbor" period

was the attached letter of December 30, 2014. (See attached **Exhibit B**) Opposer's reply letter was forwarded on January 9, 2015 and no reply of any kind was received from Applicant. (See attached **Exhibit C**) As noted in the other papers filed today, Applicant is attempting to avoid a ruling on this Rule 11 motion by filing a last minute motion to amend his answer one or two days before Opposer may file this Rule 11 motion. Opposer (as noted in its opposition/response filed today) hereby requests that Applicant's motion to amend be denied given its frivolous nature and that this Rule 11 motion be ruled upon by the Board with regard to Applicant's October 17, 2014 answer that is currently the operative pleading for this case.

## **B. Conclusion**

Given the foregoing, Opposer hereby requests a ruling from the Board on the attached Rule 11 motion that was properly served on Applicant and is now out of the "safe harbor" period of 21 days (+5 days for 1<sup>st</sup> class mail service.) Per Section C of the attached motion, Opposer requests that if Applicant does not comply with the motion, that the opposition either be sustained in its favor or that the Board issue an order to Applicant as specified in the motion. Alternatively, Opposer requests that the Board issue any other relief that it may deem just and proper.

DATED this 23<sup>rd</sup> day of January, 2015.

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////////

Respectfully submitted,

BODY VIBE INTERNATIONAL, LLC

By: 

Thomas P. Philbrick, Esq.

John E. Russell, Esq.

Attorneys for Opposer

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## EXHIBIT A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re application serial no. 85966358

Filed on June 21, 2013

BODY VIBE INTERNATIONAL, LLC	)	
	)	
Opposer,	)	
	)	Opposition No. 91215512
v.	)	
	)	Opposed Mark: DR. VAPE
Cox, David	)	
	)	
	)	
Applicant.	)	

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Trademark Trial and Appeal Board  
United States Patent and Trademark Office  
P.O. Box 1451  
Alexandria, VA 22313-1451

**OPPOSER'S MOTION FOR RULE 11 SANCTIONS WITH REGARD TO  
APPLICANT'S ANSWER FILED ON OCTOBER 17, 2014**

BODY VIBE INTERNATIONAL, LLC, a limited liability company legally organized under the laws of New Mexico, with a principal place of business of 11445 E. Via Linda, Suite 2626, Scottsdale, AZ 85259, (hereinafter "Opposer"), hereby moves the Trademark Trial and Appeal Board (the "Board") for the imposition of Rule 11 sanctions against Applicant and his attorney for the improper pleadings contained in Applicant's Answer to Opposer's first amended opposition that was filed with the Board on October 17, 2014. (See TBMP §527.02)

**A. GOVERNING LAW:**

527.02 Motion for Fed. R. Civ. P. 11 Sanctions

Fed. R. Civ. P. 11...(b) Representations to Court.

By presenting to the court a pleading, written motion, or other paper --whether by signing, filing, submitting, or later advocating it an attorney or unrepresented party certifies that to the best of the person's knowledge, information, and belief, formed after an inquiry reasonable under the circumstances:

- (1) it is not being presented for any **improper purpose**, such as to harass, **cause unnecessary delay**, or needlessly increase the **cost of litigation**;
- (2) the claims, defenses, and other legal contentions are **warranted by** existing law or by a **nonfrivolous argument** for extending, modifying, or reversing existing law or for establishing new law;
- (3) the **factual contentions have evidentiary support** or, if specifically so identified, will likely have evidentiary support after a reasonable opportunity for further investigation or discovery; and
- (4) the **denials of factual contentions are warranted on the evidence** or, if specifically so identified, are reasonably based on belief or a lack of information.

(NOTE: Bold and underline added for emphasis.)

**B. Analysis of Applicant's Averments that Violate Rule 11**

In Opposer's First Amended Notice of Opposition which was filed at the Board on July 25, 2014 and approved via Board Order on October 3, 2014, a series of averments were made in Paragraph 7 under "COUNT TWO" that relate to Applicant's YouTube and FaceBook postings. (See full text of Opposer's First Amended Opposition attached as **Exhibit A**) These averments discuss a YouTube video that appears to depict Applicant David Cox pitching his DR. VAPE branded goods at a marijuana convention in Oregon. If true, this evidence would support Opposer's allegation that Applicant's goods are not in lawful use in commerce. Further, Opposer alleges in Paragraph 7 of its amended opposition that the "attached Exhibit B" depicts Applicant's FaceBook page that discusses a "Bud of the Month" club. If true, this evidence would further support Opposer's "unlawful use in commerce" claim as it would be quite unusual for a company to promote varieties of marijuana if the underlying products sold were not intended for use with it. In short, it would be nonsensical for a business to promote the use of marijuana if its goods were not related to this market in any way.

In its answer to paragraph 7 of the amended notice of opposition, Applicant's response consisted of the following statements....

"Admit the existence of said YouTube video. Deny Applicant's device is marketed and sold primarily for use with cannabis." (See attached **Exhibit B** which is a copy of Applicant's complete answer to Opposer's first amended opposition.)

The above referenced response violates Rule 11 for several reasons. First, via this answer which was signed by Applicant's attorney, when only admitting the "existence" of the YouTube video, Applicant is not answering the averment with an affirmative or negative response, or a lack of information or belief denial. The video either depicts the Applicant David Cox or it does not and it either depicts him marketing his Dr. Vape branded goods at a marijuana conference or it does not. There is no in between answer to paragraph 7 of the amended notice of opposition and Applicant should be expected to provide a good faith substantive response to the allegation under the TTAB rules. By attempting to dodge the averment in the opposition, Applicant is presenting the answer for the improper purpose of increasing delays and costs associated with the litigation. Opposer should have a substantive affirmative or negative answer to the averment, however, at present it must conduct costly discovery and/or depositions to confirm its suspicions.

Second, via a subtle answer contained in Applicant's answer to amended notice of opposition labeled "paragraph 15," it has apparently expressly denied that the asserted YouTube video depicts the Applicant David Cox at a marijuana convention. Apparently, it has also expressly *denied* that the asserted Facebook postings are from the Applicant and promote the use of cannabis with Applicant's goods. The Applicant's paragraph 15 averment reads as follows....

"Applicant denies any allegations in the Opposition that have not been explicitly admitted."



This answer clearly violates rule 11 because the YouTube video and Facebook posts appear to clearly be attributable to the Applicant. Such an answer is frivolous and violates Rule 11 as it is a denial of “factual contention not warranted by the evidence.” There are no specific denials of the Facebook postings or the person depicted in the YouTube video of amended opposition paragraph 7, so this automatically triggers Applicant’s paragraph 15 “catch-all denial clause” that apparently denies anything not explicitly admitted. On information and belief, this is Applicant’s attempt to deceive the Board and the Opposer with a subtle express denial of certain things it knows to be true. Opposer is entitled to a clear answer of the averments such as “admitted, the attached YouTube video depicts Applicant selling his merchandise at a marijuana convention,” or “denied, the video does not depict the Applicant.” At present, given the paragraph 15 “catch-all denial,” it is unclear as to whether Applicant has expressly denied the averments in paragraph 7. Such gamesmanship is impermissible under Rule 11 as the deceptive response avers facts that are not supported by evidence.

### **C. Relief Requested**

In view of the above outlined arguments and evidence, Opposer respectfully requests an order from the Board that instructs the Applicant to respond as follows.....

1. Provide a specific on the record admission or denial of all allegations in paragraph 7 of Opposer’s amended notice of opposition. The answer must directly answer the allegation and state *whether the video depicts the Applicant*, whether the video depicts Applicant at a marijuana conference with his Dr. Vape branded goods and whether the attached FaceBook page depicts Applicant’s usage of the Dr. Vape mark in connection with a “bud of the month.” Opposer will


agree to not file this motion with the Board should Applicant file such an amended answer within the time allotted under Board rules.

2. Should the Applicant not agree to file an amended answer bringing its answer into conformity with TTAB rules (Rule 11 included), Opposer respectfully requests that the opposition be sustained in its favor and that such a terminating sanction be promptly issued by the Board.

DATED this 19<sup>th</sup> day of December, 2014.

Respectfully submitted,

BODY VIBE INTERNATIONAL, LLC

By: 

Thomas P. Philbrick, Esq.  
John E. Russell, Esq.  
Attorneys for Opposer

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2089 Avy Ave.  
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allmarktrademark@gmail.com

### **CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing **OPPOSER'S MOTION FOR RULE 11 SANCTIONS WITH REGARD TO APPLICANT'S ANSWER FILED ON OCTOBER 17, 2014** has been served on Applicant's attorney of record by mailing said copy on December 19, 2014 via First Class Mail, postage fully prepaid to:

Mark S. Hubert, P.C.  
Attn: Mark S. Hubert, Esq.  
2300 SW First Ave., Suite 101  
Portland, OR 97201

By: 

Thomas P. Philbrick

Dated: December 19, 2014

Exhibit A

mark) as identified in U.S. Serial. No. 85966358 (“Applicant’s application”) that is seeking registration in connection with “Electric vaporizers,” in International Class 11. Applicant’s last known address of record as indicated on the USPTO’s TESS database is 2359 Erma Ct., Springfield, OR 97477.

2. Opposer has used the mark DR. VAPE in interstate commerce since at least as early as January 12, 2013 (well before the application filing date and alleged first usage dates alleged in Applicant’s serial number 85966358) in conjunction with a variety of goods and services including, “Electronic cigarette liquid (e-liquid) comprised of flavorings in liquid form used to refill electronic cigarette cartridges, atomizers and vaporizer,” in International Class 30 and “Electric vaporizers,” in International Class 11. Opposer is the owner of U.S. Serial Nos. 86221601 and 86221890 (“Opposer’s marks”) for the mark DR. VAPE filed on a Section 1(a) basis, on March 14, 2014, used in connection with “Electric vaporizers,” in International Class 11 and “Electronic cigarette liquid (e-liquid) comprised of flavorings in liquid form used to refill electronic cigarette cartridges, atomizers and vaporizers,” in International Class 30. Based on Opposer’s substantial prior interstate use of its DR. VAPE marks in commerce and resulting goodwill, Opposer believes that it is being and will be damaged by the registration of Serial No. 85966358 as it creates a confusingly similar overall commercial impression to Opposer’s marks (in fact identical) and is used in connection with identical goods in International Class 11 that are also related to and complimentary to Opposer’s class 30 goods. Moreover, Opposer has priority of use in the DR. VAPE mark over Applicant based on its interstate usage in commerce prior to Applicant’s adoption, filing and alleged use in commerce of identical and/or confusingly similar DR. VAPE related marks.

3. Prior to filing its application serial numbers 86221890 and 86221601, Opposer became aware of Applicant's Application serial number 85966358 via a search of the U.S. trademark register. On the basis of similarities in appearance (identical) and fields of usage, Opposer has a reasonable belief and is in fact certain that Applicant's prior filed application will be cited as a Section 2(d) "likelihood of confusion" conflict refusal against Opposer's DR. VAPE application in class 11 upon its eventual examination by the USPTO. Opposer therefore has standing to file this opposition as the registration of its DR. VAPE mark in Classes 11, and possibly class 30 (as identified in U.S. Serial Numbers 86221601 and 86221890) will be refused (causing irreparable damage and injury to Opposer) if Applicant's application is not successfully opposed and ultimately refused registration. (Since the original filing of the opposition, the USPTO has in fact issued "Notices of Suspension" against both of Opposer's pleaded marks based upon an asserted Section 2(d) conflict with Applicant's mark identified in serial number 85966358)

4. If Applicant's application is not successfully opposed, Applicant will own the *prima facie* exclusive right to use the DR. VAPE mark in International Class 11 in connection with goods that the Examining Attorney has deemed "confusingly similar" to Opposer's DR. VAPE goods as they are identical. Such a registration would be a source of damage and injury to Opposer as it would prevent the USPTO from issuing a registration to Opposer based on its pending application serial numbers 86221601 and 86221890.

5. In view of the substantial similarity (in fact identical appearances) between Opposer's marks and Applicant's application, Opposer's prior use in commerce, and the commercial relationship between the goods/services at issue, registration of the DR. VAPE mark herein opposed to Applicant in class 11, must be refused pursuant to Section 2(d) of the

Trademark Act, 15 U.S.C. § 1052(d). The mark depicted in Applicant's application so resembles a mark previously used in the United States by Opposer and not abandoned, as to be likely, when used on or in connection with the goods or services of Applicant, to cause confusion, or to cause mistake, or to deceive.

WHEREFORE, Opposer prays that this opposition be sustained in its favor and that Serial. No. 85966358 for the mark DR. VAPE be refused in its entirety.

**COUNT TWO (Not in Lawful Use in Commerce)**

6. Opposer repeats and re-alleges the allegations in preceding preamble and paragraphs 1-5 as if fully set forth herein.

7. On information and belief, a YouTube video located at the URL (<https://www.youtube.com/watch?v=QbNP0KswWR4#t=111>) entitled "Hundreds Attend Marijuana Conference," contains recorded television footage of Applicant David Cox, confirming that his DR. VAPE branded electric vaporizer products that are the subject of this opposition are marketed and sold in interstate commerce primarily for use with cannabis which is currently illegal under federal law given that it is drug paraphernalia. (See Controlled Substances Act aka CSA §863) (Screen capture of aforementioned video is attached as Exhibit A which, on information and belief, depicts Applicant David Cox, marketing his DR. VAPE branded electric vaporizers at a marijuana conference.) In view of this information, on information and belief, Opposer believes that Applicant has in its possession, discoverable information that will establish that his electric vaporizers are intended for use primarily with cannabis and therefore constitute drug paraphernalia under The Controlled Substances Act. (See also attached Exhibit B which, on information and belief, depicts Applicant's June 2014 FaceBook posting that promotes a "Bud of the Month" cannabis to utilize in connection with his goods.)

8. Section 907, "Compliance with Other Statutes," of the Trademark Manual of Examining Procedure (TMEP) provides that the use of a mark in commerce must be a lawful use to be the basis for federal registration of the mark.

9. 37 C.F.R. §269, Compliance with other laws, provides:

"When the sale or transportation of any product for which registration of a trademark is sought is regulated under an Act of Congress, the Patent and Trademark Office may make appropriate inquiry as to compliance with such Act for the sole purpose of determining lawfulness of the commerce recited in the application. Use of a mark in commerce must be lawful use to be the basis for federal registration of the mark. Under 37 C.F.R. §2.69, the USPTO may inquire about compliance with federal laws to confirm that the applicant's use of the mark in commerce is lawful. Generally, the USPTO presumes that an applicant's use of the mark in commerce is lawful and does not inquire whether such use is lawful unless the record or other evidence shows a clear violation of law, such as the sale or transportation of a controlled substance."

10. Here, on information and belief, Applicant has violated the...

"Controlled Substances Act" (CSA) which states in part that under "21 U.S.C. §§801-971 (The Controlled Substances Act ("CSA") makes it unlawful to: manufacture, distribute, dispense, or possess a controlled substance; and sell, offer for sale, or use any facility of interstate commerce to transport **drug paraphernalia**). Regardless of state law, the federal law provides no exception to the above-referenced provisions for marijuana for "medical use." See *Gonzales v. Raich*, 545 U.S. 1, 27, 29 (2005); see also *United States v. Oakland Cannabis Buyers' Coop.*, 532 U.S. 483, 491 (2001); U.S. Const. Art. VI. Cl. 2. The examining attorney must inquire about compliance with federal laws or refuse registration based on the absence of lawful use in commerce when a court or the responsible federal agency has issued a finding of noncompliance under the relevant statute or where there has been a per se violation of the relevant statute. *Kellogg Co. v. New Generation Foods Inc.*, 6 USPQ2d 2045 (TTAB 1988); *Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80 (TTAB 1984)." (See TMEP 907, bold and underline added)

11. On information and belief, via the aforementioned YouTube video, FaceBook screen capture and additional evidence likely to be discovered, Applicant has violated 21 U.S.C. 863 which provides, in pertinent part that...

"§863. Drug paraphernalia. In general, it is unlawful for any person to sell or offer for sale drug paraphernalia; to use the mails or any other facility of interstate commerce to transport drug paraphernalia; or to import or export drug paraphernalia."... (d) "Drug paraphernalia" defined The term "drug paraphernalia" means any equipment, product, or material of any kind which is primarily intended or designed for use in manufacturing, compounding, converting, concealing, producing, processing, preparing, injecting, **ingesting, inhaling, or otherwise introducing into the human body a controlled substance, possession of which is unlawful under this subchapter**. It includes items primarily intended or designed for use in ingesting, inhaling, or



otherwise introducing marijuana, cocaine, hashish, hashish oil, PCP, or amphetamines into the human body... (Bold and underlining added)

12. On information and belief, because Applicant admittedly sells his electric vaporizers bearing the DR. VAPE mark in violation of §863 of the Controlled Substances Act (CSA), the alleged sales of the goods referenced in the application herein opposed do not and cannot constitute a lawful use of the mark for the purpose of obtaining a federal registration of the mark based on that use.

13. On information and belief, because Applicant's alleged uses of the DR. VAPE mark at least as early as May 31, 2013 were not lawful and cannot be the basis for Applicant's registration of the mark, Opposer's lawful uses of the mark in commerce at least as early as January 12, 2013 in compliance with applicable statutes including the CSA are prior to any lawful uses of the mark in commerce by Applicant and Opposer therefore has priority as to the use of the mark.

14. Opposer will be further damaged by the mark shown in the Opposed Application because such registration will give Applicant prima facie evidence of ownership of and the exclusive right to use a mark that is confusingly similar to Opposer's pleaded marks, in derogation of Opposer's rights in its marks, and for which Applicant is not entitled to registration by virtue of his unlawful use of the mark in commerce.

WHEREFORE, Opposer prays that this opposition be sustained in its favor and that Serial. No. 85966358 for the mark DR. VAPE be refused in its entirety.

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DATED this 25<sup>th</sup> day of July, 2014.

Respectfully submitted,

BODY VIBE INTERNATIONAL, LLC

By: 

Thomas P. Philbrick, Esq.

John E. Russell, Esq.

Attorneys for Opposer

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# Hundreds Attend Medical Marijuana Conference

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 by MAJ-12/SNA420  
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 by National Football Fans  
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**Minneapolis City Council for Medical Marijuana in Minnesota**  
 by BTH NORML  
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# Bud of the Month

Brought to you by: DR. VAPE

<p><b>Querkle</b> Strain: Indica, Terpenes: Linalool THC: 16.5% CBD: 0.1% Taste: Sweet, Citrusy Effects: Relaxing, Happy</p>	<p><b>Black Dahlia</b> Strain: Indica, Terpenes: Linalool THC: 21.0% CBD: 0.1% Taste: Sweet, Citrusy Effects: Relaxing, Happy</p>	<p><b>Pink Kush</b> Strain: Indica, Terpenes: Linalool THC: 19.0% CBD: 0.1% Taste: Sweet, Citrusy Effects: Relaxing, Happy</p>	<p><b>New York Sour Diesel</b> Strain: Indica, Terpenes: Linalool THC: 20.0% CBD: 0.1% Taste: Sweet, Citrusy Effects: Relaxing, Happy</p>	<p><b>Purple Cherndawg</b> Strain: Indica, Terpenes: Linalool THC: 21.0% CBD: 0.1% Taste: Sweet, Citrusy Effects: Relaxing, Happy</p>
<p><b>Eugene Blackberry Kush</b> Strain: Indica, Terpenes: Linalool THC: 18.0% CBD: 0.1% Taste: Sweet, Citrusy Effects: Relaxing, Happy</p>	<p><b>Bubblegum</b> Strain: Indica, Terpenes: Linalool THC: 20.0% CBD: 0.1% Taste: Sweet, Citrusy Effects: Relaxing, Happy</p>	<p><b>Cannatonic</b> Strain: Indica, Terpenes: Linalool THC: 17.0% CBD: 0.1% Taste: Sweet, Citrusy Effects: Relaxing, Happy</p>	<p><b>Black Bubble</b> Strain: Indica, Terpenes: Linalool THC: 21.0% CBD: 0.1% Taste: Sweet, Citrusy Effects: Relaxing, Happy</p>	<p><b>Malawi Oil</b> Strain: Indica, Terpenes: Linalool THC: 20.0% CBD: 0.1% Taste: Sweet, Citrusy Effects: Relaxing, Happy</p>



Dr. Vape  
June 21

Have you picked up your copy of The Eugene Weekly yet? Dr. Vape sponsoring home town growth (a)

Like Comment Share

14 people like this.

1 share

Dee Jacobson Lovin our home town!!!  
June 21 at 7:04pm · Like


Write a comment



### CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **OPPOSER'S MOTION FOR LEAVE TO AMEND NOTICE OF OPPOSITION AND TO EXTEND/RESET DISCOVERY PERIOD/TRIAL SCHEDULE DATES and FIRST AMENDED NOTICE OF OPPOSITION** has been served on Applicant's attorney of record by mailing said copy on July 25, 2014 via First Class Mail, postage fully prepaid to:

Mark S. Hubert, P.C.  
Attn: Mark S. Hubert, Esq.  
2300 SW First Ave., Suite 101  
Portland, OR 97201

By: 

Thomas P. Philbrick

Dated: 07/25/2014

Trademark Trial and Appeal Board Electronic Filing System. <http://estta.uspto.gov>

ESTTA Tracking number: **ESTTA633552**

Filing date: **10/17/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91215512
Party	Defendant Cox, David
Correspondence Address	MARK S HUBERT MARK S HUBERT PC 2300 SW FIRST AVE STE 101 PORTLAND, OR 97201-5047 UNITED STATES markhubert@pacifier.com;nicoleh@pacifie
Submission	Answer
Filer's Name	Mark S. Hubert, Attorney for Defendant
Filer's e-mail	markhubert@pacifier.com
Signature	/Mark S. Hubert/
Date	10/17/2014
Attachments	14-1017_Answer First Amended.pdf(3692195 bytes )

Exhibit B

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

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BODY VIBE INTERNATIONAL, LLC	:	
	:	
Opposer	:	Opposition Proceeding
	:	No. 91215512
v.	:	
	:	
DAVID COX	:	Serial No. 85966358
	:	
Applicant	:	

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Re: *Trademark Opposition*  
Serial. No. 85966352  
For: DR. VAPE  
By: David Cox  
For: Class 011. Electric Vaporizers

**ANSWER TO FIRST AMENDED OPPOSITION FOR REGISTRATION**

COMES NOW, David Cox ("Applicant"), by and through his attorney Mark S. Hubert, and answers the Notice of Opposition filed by Body Vibe International, LLC ("Opposer") in the above-identified proceeding. The numbers of the following first five paragraphs correspond to the paragraph numbers of the Opposer's Notice for Opposition.

1. Admit.
2. Applicant is without knowledge and information sufficient to form a belief as to the truth of the allegations in Paragraph 2 of Opposer's Notice of Opposition and accordingly, denies such allegations. Applicant has been unable to locate any form of market presence by Opposer. Internet and printed literature (magazine) searches have not revealed a single mention of Opposer's offer to tender for sale any



goods or services in conjunction with “electric vaporizers” and “electronic cigarette liquid (e-liquid) comprised of flavorings in liquid form used to refill electronic cigarette cartridges, atomizers and vaporizers.”

3. Applicant is without knowledge and information sufficient to form a belief as to the truth of the allegations in Paragraph 3 of Opposer’s Notice of Opposition and accordingly, denies such allegations. Opposer claims irreparable damage and injury if Applicant’s mark is registered, but fails to identify how.

4. Applicant is without knowledge and information sufficient to form a belief as to the truth of the allegations in Paragraph 4 of Opposer’s Notice of Opposition and accordingly, denies such allegations. A “likelihood of confusion” cannot exist if Opposer has no visible goods in commerce. Applicant denies that Opposer is damaged, is being damaged, and will continue to be damaged by Applicant’s registration. Applicant admits that Opposer’s goods and those for which Applicant seeks registration of the mark Dr. Vape are identical.

5. Applicant is without knowledge and information sufficient to form a belief as to the truth of the allegations in Paragraph 5 of Opposer’s Notice of Opposition and accordingly, denies such allegations. Product confusion, mistake or deception cannot occur if Opposer has no visible goods in commerce. Applicant also denies that Opposer is entitled to have said registration cancelled.

6. Applicant reiterates his responses to Opposer’s allegations in paragraphs 1-5 of his First Amended Notice of Opposition as if set forth fully herein again.

7. Admit the existence of said YouTube video. Deny Applicant’s device is marketed and sold in interstate commerce primarily for use with cannabis.



8. Admit.
9. Admit.
10. Deny.
11. Deny. Opposer's statements do not support that Applicant's device is unlawful for illegal to sell or offer to sell. If so, in light of the fact that Oposer has plead that his device is "identical" to that of Applicant's (see allegation 4 of Opposer's First Amended Notice of Opposition), Opposer's goods would also have to be deemed "drug paraphernalia."
12. Deny. Opposer continues to make reference to facts pled in Applicant's Answer not Applicant's Amended Answer. Facts in Applicant's original answer but not incorporated in amended answer are not binding on pleader.
13. Applicant is without knowledge and information sufficient to form a belief as to the truth of the allegations in Paragraph 13 of Opposer's Notice of Opposition and accordingly, denies such allegations.
14. Applicant denies that Opposer is damaged, is being damaged, and will continue to be damaged by Applicant's registration.
15. Applicant denies any allegations in the Opposition that have not been explicitly admitted.

### **DEFENSES**

Applicant asserts that none of the defenses as set forth below (affirmative or otherwise) are to be taken as an admission that Opposer has utilized the trademark "Dr. Vape" in conjunction with the sale of electric vaporizers in class 011 at least as early as January 12, 2013, or with electronic cigarette liquid (e-liquid) comprised of

flavorings in liquid form used to refill electronic cigarette cartridges, atomizers and vaporizers in class 030. In further answer to the Opposition, Applicant asserts that:

**FIRST AFFIRMATIVE DEFENSE**

16. Opposer has unclean hands. Opposer's claim to a superior mark via an earlier date of first use in interstate commerce is not based on any significant commercial sales of Opposer's claimed goods.

**SECOND AFFIRMATIVE DEFENSE**

17. Opposer has falsely marked their goods in an attempt to secure a trademark for the identical mark that Applicant filed for. The specimen sent into the USPTO is clearly a cobbled together label, falling below the standard of branding in such consumer goods, as evidenced by the quality branding used by Applicant on his goods.

**FIRST DEFENSE**

18. Although Opposer purports to have used his mark in commerce before Applicant's mark, there is no evidence that it was indeed used beyond a *de minimis* amount. This is insufficient to establish common law or other trademark rights. Applicant has rights in its mark that are superior to those of Opposer.

**SECOND DEFENSE**

19. Applicant's mark, when used in connection with Applicant's goods, is not likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection or association of Applicant with Opposer, or as to the origin, sponsorship, or approval of Applicant's goods by Opposer, because Applicant is

informed and believes, and, on that basis, alleges that the Opposer is not marketing and selling goods bearing the trademark in question.

### **THIRD DEFENSE**

20. Opposer has practiced fraud upon the Trademark Office in that it has alleged that it has used the mark "Dr. Vape" as a mark in commerce since January 12, 2013 a mere 139 days before the date of first usage in interstate commerce of the Applicant's mark. Opposer's use of the mark "Dr. Vape" is *de minimis* and is not sufficient to qualify as an actual first sale in commerce.

### **FOURTH DEFENSE**

21. Applicant's electronic vaporizer for which trademark registration is sought is its own category of identification under International Classification 011 and can also be seen trademarked as electronic pipes in International Class 034.

### **FIFTH DEFENSE**

22. Applicant's device is also an electric vaporizer, and like all electric vaporizers, is capable of use with any ignitable organic substance. Once sold, Applicant has no control over any alleged unlawful use of his device.

### **SIXTH DEFENSE**

23. Electric vaporizers are not illegal to sell under 21 U.S.C § 863 (The Controlled Substances Act) and in fact, an entire industry has grown around them. The Trademark Office has already approved numerous trademark registrations for electric vaporizers and retail outlets for electric vaporizers such as O-VAPE (4576033), Great Lakes Vapes (4508394), Wonder Vape (4521153), and CALI VAPE (4452756)

which is prima facie acknowledgement of these device's legality when their primarily intended purpose is for use with non-controlled substances.

#### **SEVENTH DEFENSE**

24. Opposer has not pointed to a single instance wherein Applicant has directly stated, or marketed his electric vaporizer for use with controlled substances such as marijuana. All Opposer's arguments rely on inferences they have drawn based on Opposer's interpretation of Youtube video footage and FaceBook/Twitter screen capture information. Opposer's argument is based on associations with cannabis but cites not one scintilla of evidence that the primary intention of Applicant's electric vaporizer is for other than use with his E-wax or nicotine fluid.

#### **EIGHTH DEFENSE**

25. Applicant's electric vaporizer is not drug paraphernalia as established by the Controlled Substances Act. *21 U.S.C. 863 (d)*. requires that to be designated as drug paraphernalia, electric vaporizers must be "primarily intended or designed" for use with controlled substances. Applicant's device is not.

#### **NINTH DEFENSE**

26. 21 U.S.C § 863 (f)(1) allows for the sale or offer to sell "any item that, in the normal lawful course of business, is imported, exported, transported, or sold through the mail or by any other means, and traditionally intended for use with tobacco products, including any pipe, paper, or accessory." Applicant's electric vaporizer fits into this category.

#### **TENTH DEFENSE**



27. The fact that the Trademark Office has already been allowing registration of goods, *to wit*: electric vaporizers and pipes in International Class 011, and the registration of services, *to wit*: sales of electric vaporizers and pipes in International Class 034 is prima facie evidence of their legality

### **Applicant's Statements**

In addition, Applicant sets forth the following statements in support of its defenses:

28. Opposer claims that Applicant's mark "Dr. Vape" is likely to cause confusion with Opposer's purported mark "Dr. Vape" but cites no acts by any consumer that support this. Applicant, David Cox, has been selling his vaporizer in interstate commerce at least as early as May 31, 2013. Applicant cannot find any trade presence of any "Dr. Vape" trademarked electric vaporizer products other than his own in class 011. This includes industry searches for marketing, customer surveys etc. via the internet and trade marketing publications.

29. There cannot be any likelihood of confusion if there is no such product of the Opposer in the market.

30. Opposer's trademark registrations 86221601 and 86221890 both show specimens that appear to be "cobbled together." Applicant believes that Opposer will not be found to have any substantial sales of his purported goods bearing the "Dr. Vape" mark in interstate commerce. Most likely, Opposer's electric vaporizer specimen was fabricated for the explicit purpose of applying for a federal trademark and using this as a basis to challenge Applicant's mark.

31. Applicant hereby appoints Mark S. Hubert, a member of the Oregon State Bar, and registered to practice before the United States Patent and Trademark Office, at the firm of:

Mark S. Hubert P.C.

2300 SW First Avenue – Suite 101

Portland, Oregon 97201

to act as the attorney of record in the matter of the Opposition identified above, to respond to said petition, to transact all business in the Patent and Trademark Office or the Trademark Trial and Appeal Board connected with the Opposition to sign his name to all papers which are hereinafter to be filed in connection therewith, and to receive all communications relating to the same.

**RELIEF REQUESTED**

16. WHEREFORE, Applicant respectfully requests as follows:

(a) this opposition be dismissed with prejudice and order such other relief as it deems appropriate.

(b) a registration for the term Dr. Vape be issued to the Applicant.

Respectfully submitted this 17<sup>th</sup> day of October 2014,

By: 

Mark S. Hubert, OSB No. 982564

Mark S. Hubert P.C.

2300 SW First Ave, Suite 101

Portland, OR 97201

Telephone: (503) 234 7711

[markhubert@pacifier.com](mailto:markhubert@pacifier.com)

Attorney for Applicant, David Cox

### **CERTIFICATE OF FILING**

I HEREBY CERTIFY that the foregoing document was filed electronically via the ESTTA, at the United States Patent and Trademark Office, Trademark Trial and Appeal Board's ESTTA electronic filing system, this 17<sup>th</sup> day of October, 2014.

By:   
Mark S. Hubert, OSB No. 982564  
Mark S. Hubert P.C.  
2300 SW First Ave, Suite 101  
Portland, OR 97201  
Telephone: (503) 234 7711  
[markhubert@pacifier.com](mailto:markhubert@pacifier.com)  
Attorney for Applicant, David Cox

### **CERTIFICATE OF SERVICE**

The undersigned does hereby certify that on this 17<sup>th</sup> day of October 2014, a true and correct copy of this ANSWER TO FIRST AMENDED OPPOSITION FOR REGISTRATION in Opposition 91215512 has been served upon the Attorney for Opposer by mailing the same by U.S. Mail, first-class, postage paid, to the Attorney at his address of record, as follows:

Thomas P. Philbrick  
Allmark Trademark  
2089 Avy Ave.  
Menlo Park, CA 94025

By:   
Mark S. Hubert, OSB No. 982564  
Mark S. Hubert P.C.  
2300 SW First Ave, Suite 101  
Portland, OR 97201  
Telephone: (503) 234 7711  
[markhubert@pacifier.com](mailto:markhubert@pacifier.com)  
Attorney for Applicant, David Cox

## EXHIBIT B



**MARK S. HUBERT, P.C.**  
Patent Prosecution & Intellectual Property Litigation

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2300 SW First Avenue, Suite 101  
Portland, OR 97201  
Telephone: (503) 234-7711

December 30, 2014

Thomas P. Philbrick  
Allmark Trademark  
2089 Avy Ave.  
Menlo Park, CA 94025

Mr. Philbrick;

**RE: Permission to File Amended Pleading**

I am in receipt of your proposed Motion for Rule 11 Sanctions, dated December 19, 2014. It appears that I did not address what you consider an allegation in paragraph 7 of your First Amended Notice of Opposition. Since it was contained in quotation marks, and prefaced with "See" I did not treat it as anything other than a reference.

I have prepared Applicant's First Amended Answer to First Amended Notice of Opposition and I am prepared to file it, however since more than 20 days have passed pursuant to FRCP 15(a) and TBMP 507.02 I may amend its pleading only by written consent of every adverse party or by leave of the Board. I am assuming that you have, or are giving me this written consent in paragraphs 1 and 2, pages 4 and 5 of your Opposer's Motion for Rule 11 Sanctions With Regard to Applicant's Answer Filed on October 17, 2014.

Please confirm if this is the case. Upon confirmation I will file the amendment as unopposed and preface it with a statement as to your written permission.

Cordially,



Mark S. Hubert

---

Mark S. Hubert\*♦  
markhubert@pacifier.com

Nicole E. Hyatt♦  
nicoleh@pacifier.com

\*Oregon State Bar Member  
♦Registered to Practice Before the USPTO

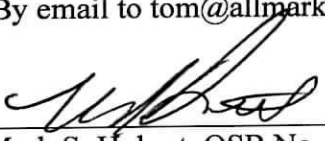
**CERTIFICATE OF SERVICE**

The undersigned does hereby certify that on this 30<sup>st</sup> day of December 2014, a true and correct copy of this letter (**RE: Permission to File Amended Pleading**) in Opposition 91215512 has been served upon the Attorney for Opposer by mailing the same by U.S. Mail, first-class, postage paid, to the Attorney at his address of record, as follows:

Thomas P. Philbrick  
Allmark Trademark  
2089 Avy Ave.  
Menlo Park, CA 94025

And By email to tom@allmarktrademark.com

By: \_\_\_\_\_

  
Mark S. Hubert, OSB No. 982564  
Mark S. Hubert P.C.  
2300 SW First Ave, Suite 101  
Portland, OR 97201  
Telephone: (503) 234 7711  
[markhubert@pacifier.com](mailto:markhubert@pacifier.com)  
Attorney for Applicant, David Cox

## EXHIBIT C

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**ALLMARK TRADEMARK ®**

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*2089 Avy Ave.  
Menlo Park, CA 94025  
Telephone: 650-233-2789  
Fax: 650-233-2791*

January 9, 2015

**VIA FIRST CLASS MAIL and EMAIL TO markhubert@pacifier.com**

Mark S. Hubert, P.C.  
Attn: Mark S. Hubert, Esq.  
2300 SW 1<sup>st</sup> Ave., Suite 101  
Portland, OR 97201

**Re: David Cox's request for permission to file Amended Answer Pleading in Dr.  
Vape trademark opposition number 91215512**

Dear Mr. Hubert,

We are in receipt of your December 30, 2014 letter with the caption of "RE: Permission to File Amended Pleading." We appreciate your apparent willingness to attempt to resolve the Rule 11 violations contained in your October 17, 2014 answer to first amended opposition. However, your December 30<sup>th</sup> letter only indicates a willingness to amend the answer relating to the referenced FaceBook allegation. While certainly one of the problems with your amended answer, it certainly isn't the only violation as discussed in our draft motion for Rule 11 sanctions.

Our concern with simply granting my client's unconditional consent for you to file an amended answer is that given your December 30<sup>th</sup> letter, your amended answer sounds like it would almost certainly contain what in our view are similar and/or identical Rule 11 violations with perhaps the only cure being in relation to the allegation regarding your clients FaceBook page. This would leave my client in the predicament of seeing your amended answer only upon its filing and then having to draft a different and revised Rule 11 motion for service on your office, with a renewed waiting period before service at the TTAB. This obviously isn't practical nor what is contemplated under the Rule 11 procedure.

In an effort to avoid the anticipated merry-go-round of revised and resubmitted Rule 11 Motions, Body Vibe suggests what it believes to be a reasonable compromise. In an effort to resolve this Rule 11 issue short of TTAB intervention, Body Vibe requests that it be permitted to review your proposed amended answer draft before it is submitted at the TTAB. If Body Vibe believes the Rule 11 issues to be cured in the draft amended answer, then it will provide its consent for the filing of the amended answer. On the

other hand, if any of the Rule 11 issues outlined in its draft motion for Rule 11 sanctions remain, then it will not provide its consent and will instead proceed with the filing of the motion at the TTAB.

To be clear, under Rule 11, Body Vibe is entitled to admissions or denials of the allegations in paragraph 7 that are presented in a good faith manner, not simply evasive statements such as "said YouTube video exists." To comply with the spirit of Rule 11, everything contained in paragraph 7 needs to be expressly admitted or denied in a clear manner so that Body Vibe knows where Mr. Cox stands. Further, Mr. Cox's catch-all denial in paragraph 15 of its October 17<sup>th</sup> answer needs to be clarified to determine if he is denying significant portions of Body Vibe's paragraph 7 of its amended notice of opposition.

We trust that Mr. Cox is agreeable to Body Vibe's request to review the proposed amended answer before consent to file can be contemplated. Please provide your response and the amended answer draft by 5pm Pacific Time on January 14<sup>th</sup>, otherwise Body Vibe will proceed with the filing of the Rule 11 motion with the TTAB. Please call or email with any follow up questions that you may have. Thank you.

Sincerely,

A handwritten signature in black ink, appearing to read "Thomas P. Philbrick", written over a horizontal line.

Thomas P. Philbrick, Esq.

John E. Russell, Esq.

ALLMARK TRADEMARK ®

Attorneys for Body Vibe  
International, LLC

Phone: (650)233-2789

Email: tom@allmarktrademark.com

CC: Body Vibe International, LLC

### **CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing **OPPOSER'S MOTION FOR RULE 11 SANCTIONS AGAINST APPLICANT WITH RESPECT TO ANSWER FILED OCTOBER 17, 2014** has been served on Applicant's attorney of record by mailing said copy on January 23, 2015 via First Class Mail, postage fully prepaid to:

Mark S. Hubert, P.C.  
Attn: Mark S. Hubert, Esq.  
2300 SW First Ave., Suite 101  
Portland, OR 97201

By: 

Thomas P. Philbrick

Dated: 01/23/2015